

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA**

THE UNIVERSITY OF AUCKLAND,)	Civil Action
)	
Plaintiffs,)	No. <u>3:16-cv-167</u>
)	
v.)	
)	
SPORTSWEAR INC. d/b/a PREP)	
SPORTSWEAR,)	<u>Electronically Filed</u>
)	
Defendant.)	

COMPLAINT

Plaintiff, the University of Auckland (“Plaintiff” or “the University”) by and through its counsel, aver the following in support of its Complaint against Defendant, Sportswear Inc. d/b/a Prep Sportswear (“Defendant” or “Sportswear”):

JURISDICTION AND VENUE

1. This is an action for trademark infringement, false designation of origin, and unfair competition, arising under the Federal Trademark Act of 1946, 15 U.S.C. § 1051 *et seq.* (“Lanham Act”), as well as the law of Pennsylvania and other applicable common law.

2. This Court has subject matter jurisdiction under section 39 of the Lanham Act, 15 U.S.C. § 1121, and under 28 U.S.C. §§ 1331 and 1338. This Court has jurisdiction over Plaintiffs related state and common law claims pursuant to 28 U.S.C. §§ 1338 and 1367.

3. Personal jurisdiction and venue are proper in this District pursuant to 28 U.S.C. §§ 1391(b) and 1391(c) because, upon information and belief, Defendant has transacted business in this Commonwealth on a substantial and continuous basis and particularly in this District by selling, marketing, advertising and offering for sale products that bear the trademarks of Plaintiff and other third-parties located in this district. Defendant’s website, www.prepsoprtswear.com, is

an interactive website that is accessible in this Commonwealth and this District that sells, markets, advertises and offers to sell products targeted at residents of Pennsylvania and this District by selling products bearing the names and marks of schools and entities located in Pennsylvania and this District, including, but not limited to, Allegheny College, Butler County Community College, Carnegie Mellon University, California University of Pennsylvania, Chatham University, Carlow University, Duquesne University, Edinboro University, Grove City College, Indiana University of Pennsylvania, La Roche College, Pittsburgh Institute of Aeronautics, Pittsburgh Technical Institute, Point Park University, Saint Vincent College, Seton Hill University, Slippery Rock University, University of Pittsburgh Greensburg, University of Pittsburgh Johnstown, Washington and Jefferson College, Westminster College, Westmoreland County Community College and virtually every elementary, middle, and high school in this District. *See, e.g.*, attached Exhibit A. Every school or entity listed on prepsportswear.com is provided its own storefront. Sportswear even provides storefronts entitled “Pittsburgh Hockey Apparel Store,” “Pittsburgh Football Apparel Store,” and “Pittsburgh Apparel Store,” respectively. *See* attached Exhibit B.

4. Defendant has caused harm to Plaintiff in this District by its acts of trademark infringement.

THE PARTIES

5. Plaintiff The University of Auckland is a New Zealand university having an address at 24 Princes Street, Auckland, 1010, New Zealand.

6. Upon information and belief, Defendant Sportswear, Inc. d/b/a Prep Sportswear is a corporation organized under the laws of the State of Washington and having an address at 2211 Elliott Avenue, Suite 601, Seattle, Washington 98121.

BACKGROUND

7. The University of Auckland was founded in 1883. It is a world renowned and New Zealand's largest and pre-eminent research university. The University has been using the marks THE UNIVERSITY OF AUCKLAND and AUCKLAND UNIVERSITY ("the Auckland marks") since its inception to distinguish itself as New Zealand's premier research institution. The University has been using the Auckland marks in the United States for decades.

8. The University is the owner of United States Trademark Registration No. 4,844,283, for the mark THE UNIVERSITY OF AUCKLAND in connection with educational services and clothing ("the Auckland Registration"). A copy of this registration is attached hereto as Exhibit C.

9. The University has substantially exclusively and continuously offered educational services since its founding in 1883, including in commerce in the United States since 1988, under the Auckland marks. The University has provided such educational services under the marks AUCKLAND UNIVERSITY and/or THE UNIVERSITY OF AUCKLAND continuously since its founding. The University has substantially exclusively and continuously been using the Auckland marks on clothing, apparel and accessories, in the United States anywhere at least as early as 1988 and in commerce at least as early as March 2011. Since at least the 1920s, the University has adopted, as its primary color scheme, blue and white, as demonstrated by attached Exhibit D, showing examples of University letterhead dating back to 1926, Exhibit E, showing University logos from 1993-2014, Exhibit F, showing additional historical examples of the University's use a blue and white color scheme and the Auckland marks, and the screenshots below:

Welcome - The University of Auckland

https://www.auckland.ac.nz/en.html

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- Future postgraduates
- Current students
- International students
- Staff
- Alumni and friends
- Business, employers and community
- Parents and family
- The media

ABOUT

- The University
- Programmes and courses
- Admission and enrolment
- Learning and teaching
- Research
- Perspectives
- International Strategy
- Māori in Tāmaki Makaurau | Māori at the University
- Pacific at the University
- Equity at the University | Te Ara Tautika
- Living to Auckland
- Careers at Auckland
- News, events and notices

Welcome to the University of Auckland

Current students
Future undergraduates
Future postgraduates
International students

Join us for the 2016 Poetry Slam. We have International guest judges, awesome prizes, and free pizza on the night. Register now!

Notices Student safety - University of Auckland commitment

What's happening

Equality deferred: Human rights law in Canada
NZ Centre for Human Rights Law, Policy and Practice public lecture by Professor Dominique Clement.

News
Using computers to better understand human physiology
03 May 2016
For this year's Gibbons lecture series at the University of Auckland, Distinguished Professor Peter Hunter of the University's Bioengineering Institute will give a free public lecture.
Marijuana use increases risks in pregnancy
02 May 2016
Women using marijuana during pregnancy have an increased risk of spontaneous pre-term birth according to new research.
Food retailers need to consider school students
27 April 2016
Food retailers near schools may need to consider ways to reduce children's exposure to

Upcoming events

Graduation Service
Graduates, their families and friends are invited to attend a short Service of Thanksgiving for the gifts of intellect and learning, and for personal accomplishment in reaching the point of graduation.

Events
Gibbons Series: Computational Physiology
05 May 2016, 6-8pm
In the first lecture of the Gibbons Series, Distinguished Professor Peter Hunter (Director, Auckland Bioengineering Institute) will address the use of computer models that improve understanding of human physiology and proposed treatments of diseases.
Re-inventing New Zealand: Essays on the arts and the media book launch
(School of Social Sciences, Media, Film and Television) 05 May 2016, 6 - 8pm
Abama Press would like to invite you to celebrate the launch of Roger Horrocks' "Re-inventing New Zealand: Essays on the arts and the media" at the Gus Fisher Gallery.

Study options
Find a programme or degree that's right for you.

University Directory
Find staff and doctoral candidates at the University of Auckland.

Media directory
Find staff with specialised knowledge for your media query.

The Inside Word
Read our blog written by first-year students about what it's like to study at the University.

Opinion
Our academics regularly comment on and contribute to the news.

Student perspectives
Take a look at some of the amazing work our students are doing.

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- Business School
- National Institute of Creative Arts and Industries
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The University of Auckland

https://www.auckland.ac.nz/en/about/the-university.html

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- Current students
- International students
- Staff
- Alumni and friends
- Business, employers and community
- Parents and family
- The media

ABOUT

- The University
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- Mission and values
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- How the University works
- Affiliations and associations
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- Māori in Tāmaki Makaurau | Māori at the University
- Pacific at the University
- Equity at the University | Te Ara Tautika
- Living to Auckland
- Careers at Auckland
- News, events and notices

The University

Founded in 1863, Auckland is the country's largest university with over 40,000 students, nearly 10,000 of whom graduate annually. The main campus is in the heart of Auckland city and we have four specialist campuses.

Message from the Vice-Chancellor
Meet Vice-Chancellor Professor Stuart McCutcheon.

New Zealand's world-ranked university
Get a quick overview of the University, including key facts and figures.

Mission and values
The Mission and Values of the University of Auckland as set out in the Strategic Plan 2013-2020.

University history
Read about our beginnings in a disused courthouse and jail.

How the University works
Understand our management and committee structure and find out about our campuses.

Official publications
Read about the key objectives in the Strategic Plan 2013-2020 or download the Annual Report.

Affiliations and associations
The University of Auckland has some key alliances with national and international institutions.

Campus Store
Shop the University branded clothing, memorabilia and Goldie Wines range.

Contact us
Key contacts including where to go for course information, media and alumni enquiries, and emergencies.

A to Z directory
A comprehensive directory for all academic and commercial facilities on campus.

FACULTIES, INSTITUTES, CAMPUSES AND LIBRARY

- Faculty of Arts
- Business School
- National Institute of Creative Arts and Industries
- Faculty of Education and Social Work
- Faculty of Engineering
- Faculty of Law
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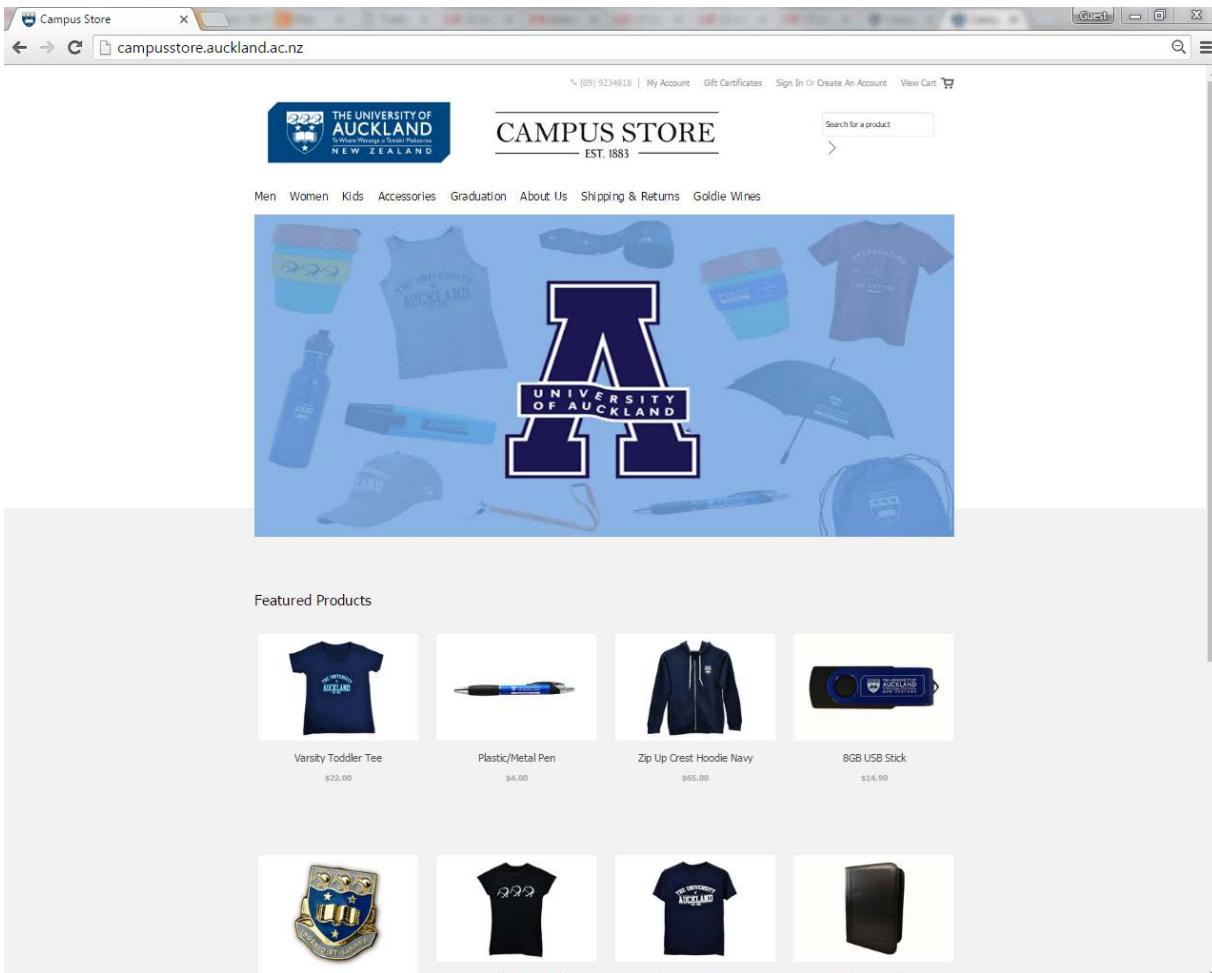
Accommodation

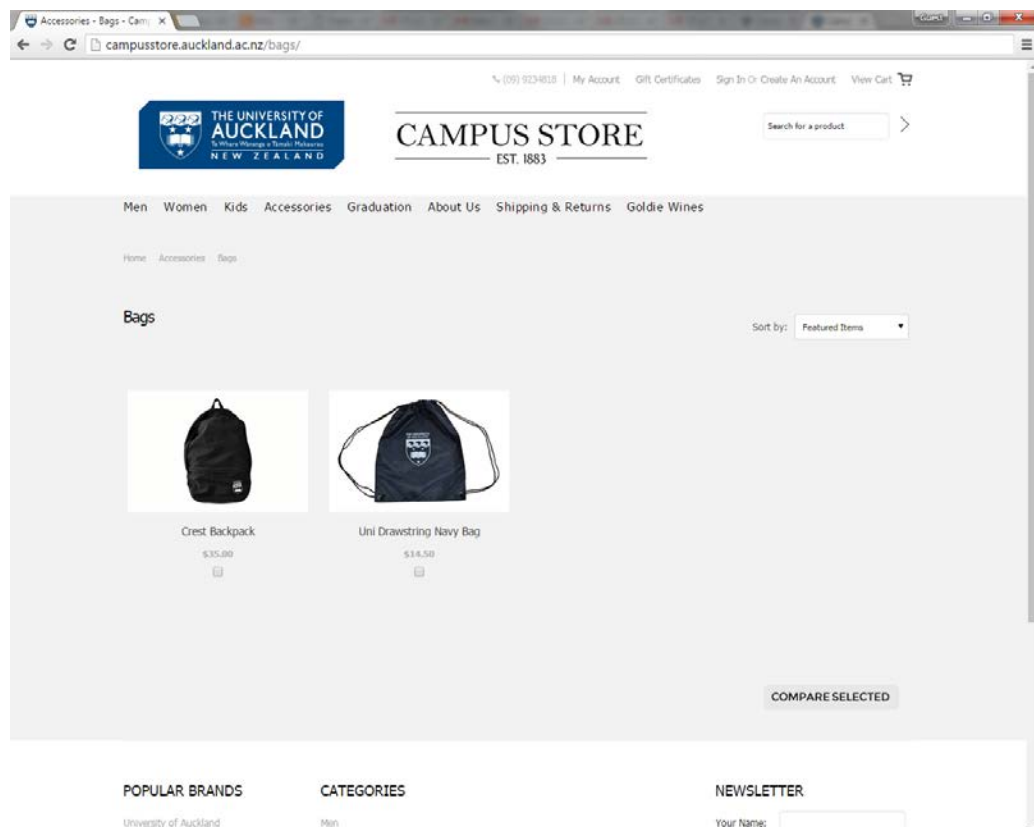
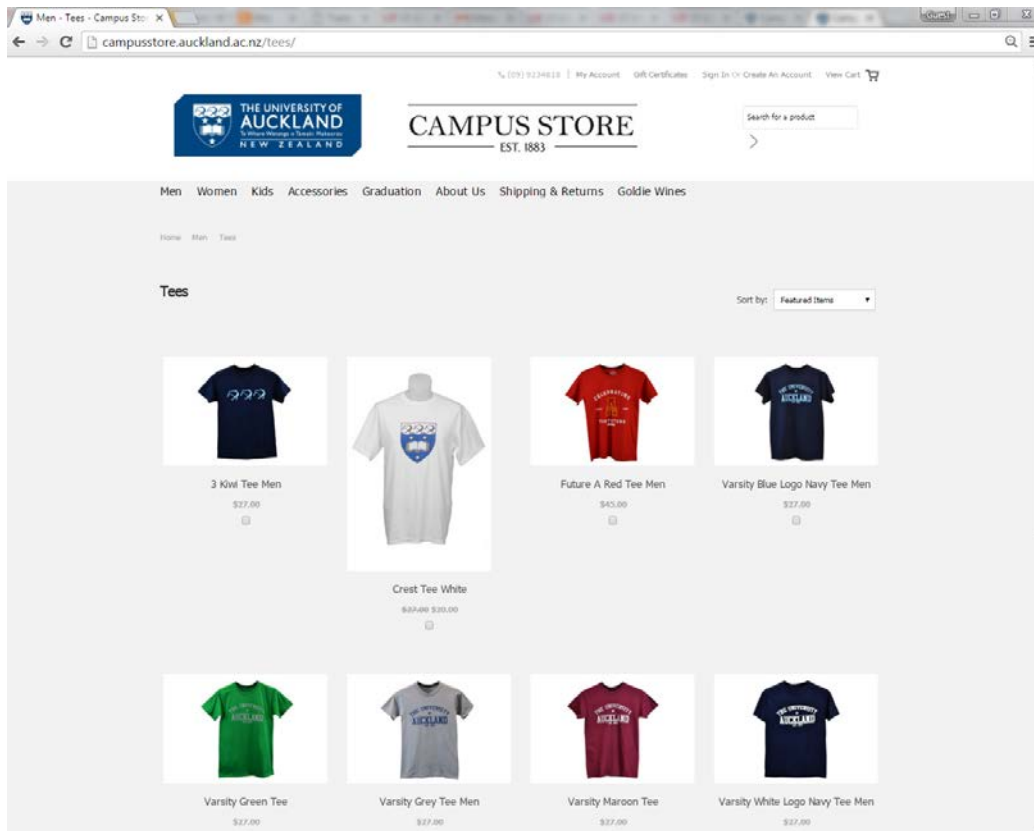
Connect with us

f t y in

10. Exhibit F further includes an advertisement from the New Zealand Herald, Volume LXX, Issue 21396, 21 January 1933, Page 19, advertising the blue blazer depicted in Exhibit F.

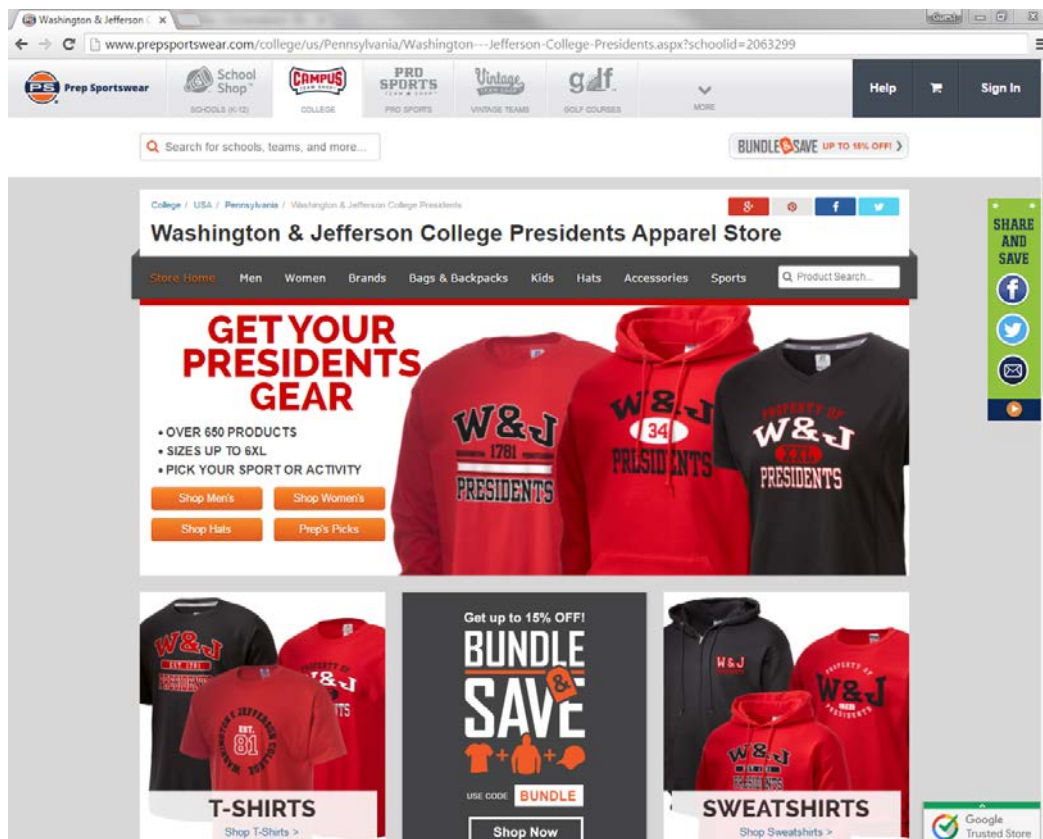
11. The University's online "Campus Store" (campusstore.auckland.ac.nz) offering products bearing the Auckland marks, has been operating since at least 2011, including in the United States. Screenshots showing examples of such products are provided below:

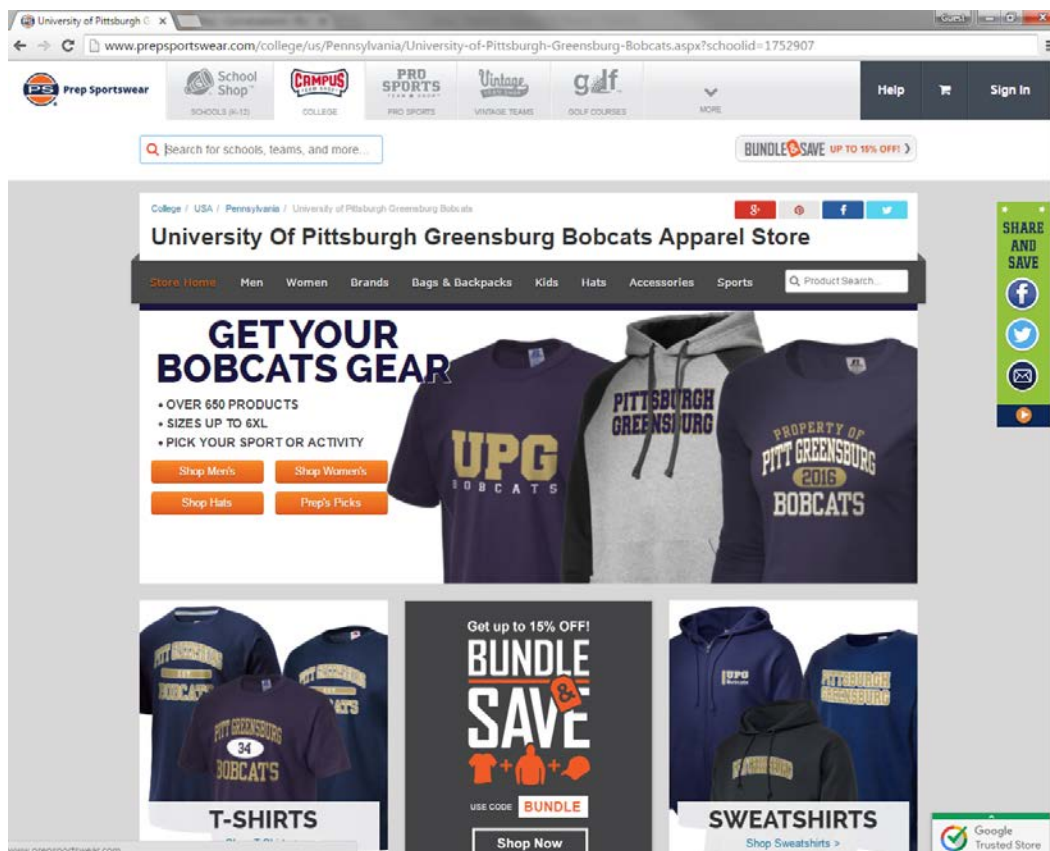
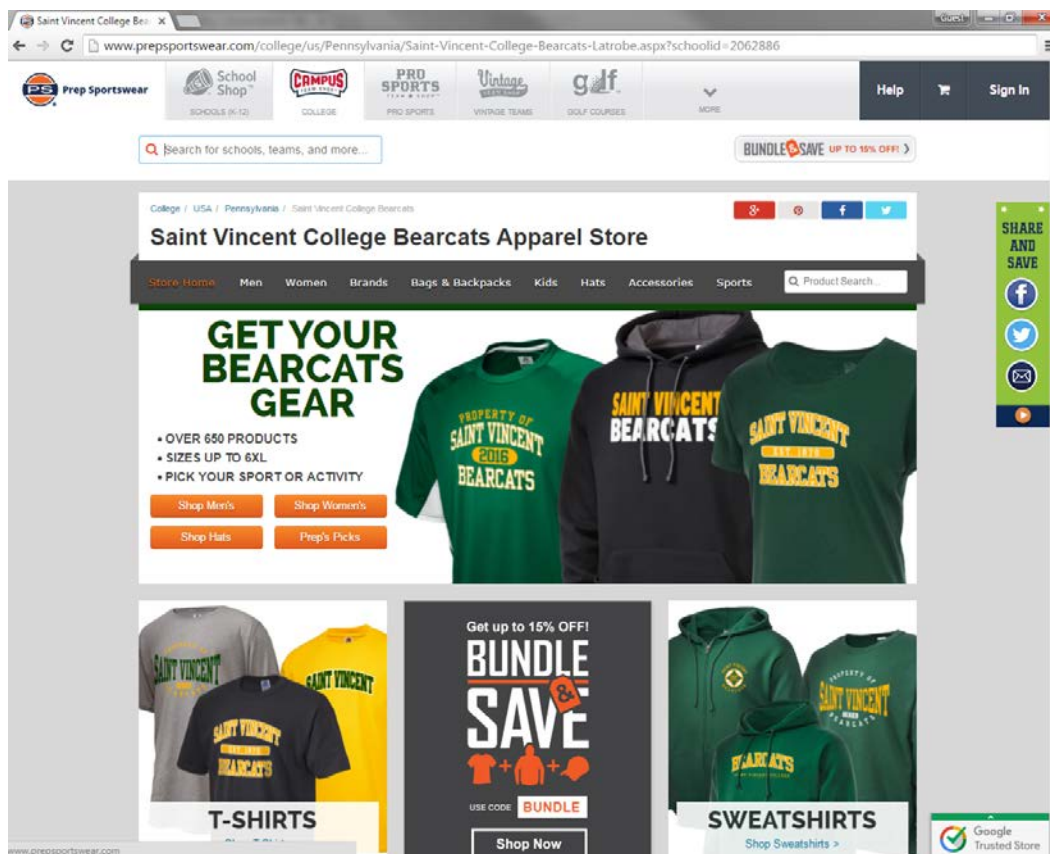




12. As a result of the University's extensive use of the Auckland marks, the Auckland marks have gained significant goodwill and notoriety and a reputation worldwide and in the United States of being associated with a world class research University. The University has expended significant efforts and resources in making the Auckland marks well-known to the public.

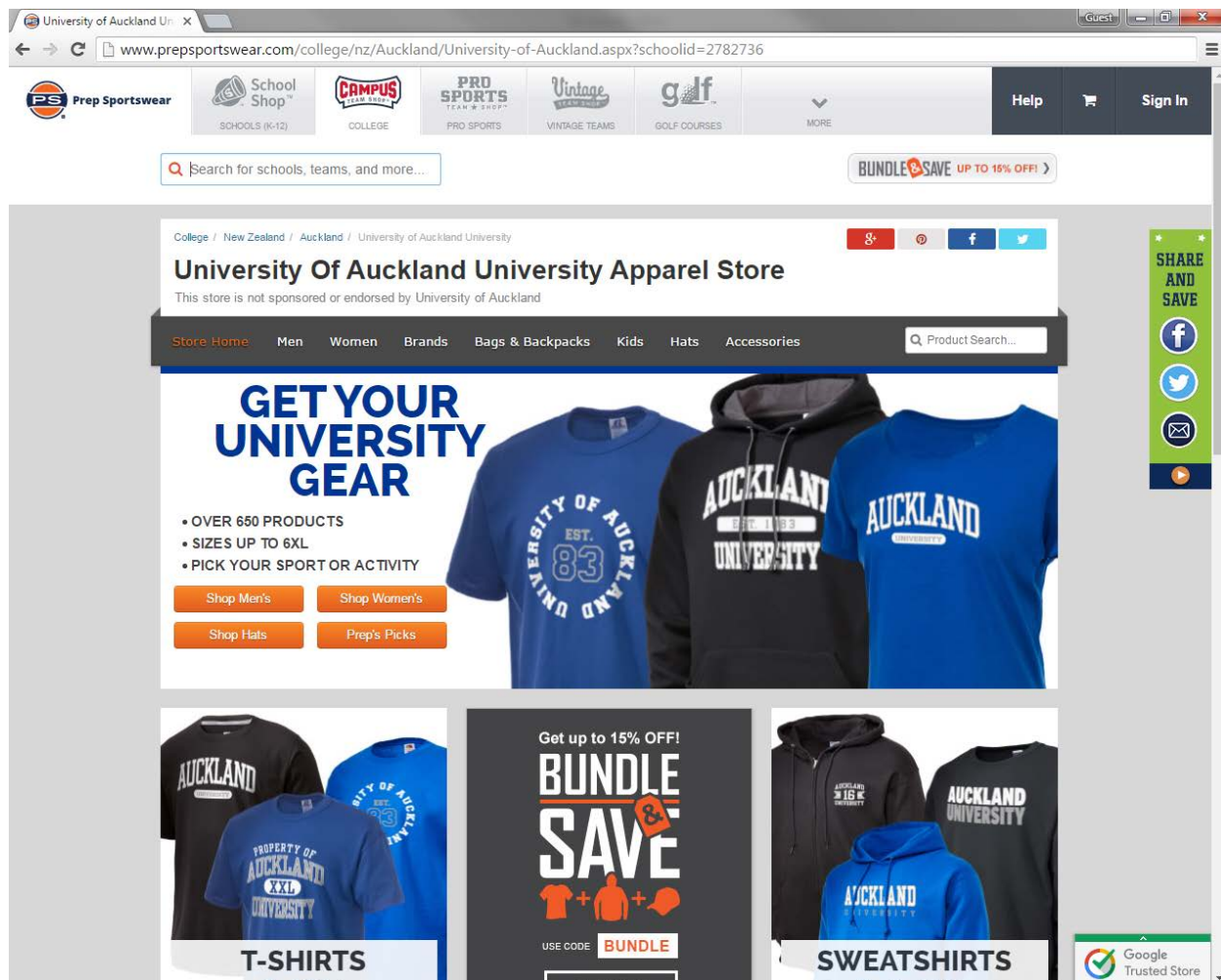
13. Upon information and belief, Defendant Sportswear is in the business of marketing and selling apparel and related goods and accessories bearing the marks of hundreds of colleges, universities, high schools, middle schools, elementary schools, sports teams, and other institutions. These products are sold and offered for sale through Sportswear's website, www.prepsportswear.com. The website www.prepsportswear.com offers hundreds of storefronts, each storefront being entitled according to the following format: "[Entity/School/Mascot Name] Apparel Store." The following are examples of storefronts featured on www.prepsportswear.com:





14. Upon information and belief, it appears that a majority of the apparel and related goods and accessories sold and offered for sale on www.prepsportswear.com is not authorized or licensed by the entities featured on www.prepsportswear.com.

15. Sportswear operates a storefront offering unauthorized University of Auckland apparel and merchandise under the name “University Of Auckland University Apparel Store.” A screenshot of the same is as follows:



16. Sportswear offers t-shirts, sweatshirts, pants, bags, outerwear, hats, scarves, and towels, among other things, bearing the Auckland marks and appropriating the University’s color scheme and themes (e.g., “EST. 1883”). The University has never authorized or otherwise

approved of Sportswear's use of the Auckland marks, the University's color scheme, themes or other indicia indicating an association with the University.

17. The goods upon which Sportswear uses the Auckland marks are identical to those sold by the University on its online store at <http://campusstore.auckland.ac.nz/> and identified on the Auckland Registration.

18. Sportswear's "University Of Auckland University Apparel Store" so prominently features the Auckland marks and the University's color schemes and themes that it creates the false commercial impression that Sportswear is affiliated with the University and that Sportswear's use of the Auckland marks is approved of, sponsored, licensed, or otherwise authorized by the University. The Auckland marks are the most dominant aspects of the products offered on Sportswear's "University Of Auckland University Apparel Store." Even the title of Sportswear's University of Auckland page falsely suggests an affiliation with the University. As a result of Sportswear's misappropriation of the Auckland marks and the University's color schemes and themes, consumers are likely to be confused that Sportswear is affiliated with the University and authorized to use the Auckland marks.

19. The University has exchanged several letters through counsel with Sportswear concerning its infringement of the Auckland marks. In response to the University's last letter, dated March 1, 2016, Sportswear responded that because each page included a disclaimer that it was not sponsored or endorsed by the University, it was free from liability. Notably, the disclaimer present in the above image, namely, "This store is not sponsored or endorsed by the University of Auckland," was not present on the "University of Auckland University Apparel Store" page until after the University sent its March 1, 2016 letter. The only disclaimer on that page was barely visible and hidden at the very bottom of the webpage. See the screenshots from March 1, 2016

attached hereto as Exhibit G. Sportswear's disclaimers are not prominent and, in any event, do not negate the overall false commercial impression that Sportswear is somehow affiliated with the University and authorized to use the Auckland marks.

20. Sportswear's use of the Auckland marks and other confusingly similar indicia indicating an association with the University is directly competitive with goods offered by the University, identified on the Auckland Registration, and/or within the University's natural zone of expansion. Sportswear's use is commercial in nature and is intended to compete with The University and its authorized licensees to the detriment of the University. On information and belief, Sportswear's use of the Auckland marks and other confusingly similar indicia indicating an association with the University is intended to create an improper association between Sportswear and the University and to mislead and confuse consumer that Sportswear's goods are provided, sponsored, affiliated with, licensed or approved by the University, particularly in view of Sportswear's previous notification of its infringement by the University. Accordingly, Sportswear has willfully infringed the Auckland marks and traded on the goodwill and reputation of the University and as embodied in the Auckland marks.

21. As a result of Sportswear's conduct, the University has suffered irreparable harm which will continue unless Sportswear is enjoined from infringing the University's trademark rights.

Count I
(Trademark Infringement Under 15 U.S.C. § 1114)

22. The University repeats and realleges the averments contained in paragraphs 1 through 20 of this Complaint as if fully stated herein.

23. The University is the sole and exclusive owner of United States Trademark Registration No. 4,844,283, for the mark THE UNIVERSITY OF AUCKLAND, attached hereto as Exhibit C (“the Auckland Registration”).

24. The Auckland Registration covers the following goods and services:

In international class 25: Clothing, namely, shirts, t-shirts, hooded sweatshirts, hats, scarves, ties and gloves.

In international class 41: Educational services, namely, providing study abroad and exchange programs in the fields of economics, philosophy, history, Pacific studies, anthropology, politics, international relations, geography, media, film and television, accounting, architecture, biology, chemistry, engineering, computer science, education, English, environmental science, finance, geology, international business, law, linguistics, Maori, mathematics, medical science, management, marketing, music, physics, sociology, statistics.

25. Sportswear’s use of the Auckland marks, the University’s color scheme, themes and/or other indicia indicating an association with the University are likely to cause confusion, deception and mistake by creating the false and misleading commercial impression that Sportswear’s goods and services are provided, sponsored, endorsed, licensed or approved by and that Sportswear is associated or affiliated with the University. Such use by Sportswear constitutes infringement of the Auckland marks and the Auckland Registration in violation of 15 U.S.C. § 1114.

26. Sportswear’s conduct has demonstrated an intentional, willful, and malicious intent to trade on the goodwill and reputation associated with the Auckland marks and the University.

27. If Sportswear's conduct is not enjoined, Sportswear's conduct will continue to create a likelihood of confusion, deception and mistake among members of the consuming public, and the University has been, and is likely to continue to be, irreparably harmed and damaged by Sportswear's acts of trademark infringement for which there is no adequate remedy at law, in that the University has suffered and will continue to suffer a destruction of its goodwill and reputation, as well as lost sales each time customers believe that the goods and services of Sportswear are provided, sponsored, endorsed, licensed or approved by or that Sportswear is associated or affiliated with the University.

Count II

(False Designation of Origin and Unfair Competition Under 15 U.S.C. § 1125(a))

28. The University repeats and realleges the averments contained in paragraphs 1 through 26 of this Complaint as if fully stated herein.

29. Through the extensive use of the Auckland marks, which has been substantially exclusive and continuous, for decades internationally and in the United States, the University has developed significant goodwill and reputation in the Auckland marks, and such marks are protectable under 15 U.S.C. § 1125(a).

30. Sportswear's use of the Auckland marks, the University's color scheme, themes and/or other indicia indicating an association with the University are likely to cause confusion, deception and mistake by creating the false and misleading commercial impression that Sportswear's goods and services are provided, sponsored, endorsed, licensed or approved by and that Sportswear is associated or affiliated with the University. Such use by Sportswear constitutes false representations, false descriptions, and false designations of origin of the goods and services provided by Sportswear under the Auckland marks and Sportswear's "University Of Auckland University Apparel Store" and unfair competition in violation of 15 U.S.C. § 1125(a).

31. Sportswear's conduct has demonstrated an intentional, willful, and malicious intent to trade on the goodwill and reputation associated with the Auckland marks and the University.

32. If Sportswear's conduct is not enjoined, the University is likely to continue to be irreparably harmed and damaged by Sportswear's acts of unfair competition and false designation of origin for which there is no adequate remedy at law, in that the University has suffered and will continue to suffer a destruction of its goodwill and reputation, as well as lost sales each time customers believe that the goods and services of Sportswear are provided, sponsored, endorsed, licensed or approved by or that Sportswear is associated or affiliated with the University.

Count III
(Common Law Unfair Competition)

33. The University repeats and realleges the averments contained in paragraphs 1 through 31 of this Complaint as if fully stated herein.

34. Sportswear's aforementioned conduct in connection its use of the Auckland marks, the University's color scheme, themes and/or other indicia indicating an association with the University constitutes unfair competition at common law.

35. Sportswear's conduct has demonstrated an intentional, willful, and malicious intent to engage in such unfair competition under the common law.

36. If Sportswear's conduct is not enjoined, the University is likely to continue to be irreparably harmed and damaged by Sportswear's acts of unfair competition for which there is no adequate remedy at law, in that the University has suffered and will continue to suffer a destruction of its goodwill and reputation, as well as lost sales each time customers believe that the goods and services of Sportswear are provided, sponsored, endorsed, licensed or approved by or that Sportswear is associated or affiliated with the University.

WHEREFORE, the University prays for judgment that:

A. Sportswear, by its adoption and usage of the Auckland marks and the Auckland marks the University's color scheme, themes and/or other indicia indicating an association with the University has infringed the University's trademark rights in violation of 15 U.S.C. § 1114;

B. Sportswear by its adoption and usage of the Auckland marks and the Auckland marks the University's color scheme, themes and/or other indicia indicating an association with the University has infringed the University's trademark rights in violation of 15 U.S.C. § 1125;

C. Sportswear by its adoption and usage of the Auckland marks and the Auckland marks the University's color scheme, themes and/or other indicia indicating an association with the University has infringed the University's common law rights;

D. Sportswear, by reason of its knowledge of the University's ownership and prior use of and goodwill and reputation associated with the Auckland marks, and nevertheless adopting and continuing to use the Auckland marks in connection with the University's color scheme, themes and/or other indicia indicating an association with the University has intentionally and willfully committed trademark infringement and unfair competition;

E. Sportswear and those persons in active concert or participation with Sportswear be preliminarily and permanently enjoined and restrained from using the Auckland marks and any other mark confusingly similar thereto and the color scheme, themes or any other indicia tending to indicate an association with the University in connection with its business;

F. All labels, boxes, cartons, signs, catalogs, literature, packages, marketing materials, and advertisements of Sportswear bearing the Auckland marks and/or any other mark confusingly similar thereto be delivered and destroyed as the Court may direct pursuant to 15 U.S.C. § 1116;

G. Sportswear be ordered to account to the University for any and all profits derived by it by reason of its conduct complained of herein pursuant to 15 U.S.C. §§ 1114, 1117 and 1125;

H. Sportswear be ordered to pay damages to the University for injuries sustained by the University as a result of Sportswear's infringement of the University's trademarks, in an amount to be determined at trial, pursuant to 15 U.S.C. §§ 1114 and 1117;

I. Sportswear be ordered to pay damages to the University for injuries sustained by the University as a result of Sportswear's unfair competition and false designations of origin, in an amount to be determined at trial, pursuant to 15 U.S.C. §§ 1125 and 1117;

J. Sportswear be ordered to pay treble damages to the University pursuant to 15 U.S.C. § 1117(b);

K. The University be awarded its costs and reasonable attorney's fees pursuant to 15 U.S.C. § 1117 and common law; and

L. The University be awarded such further relief as the Court shall deem appropriate.

Respectfully submitted,
THE WEBB LAW FIRM

Dated: July 18, 2016

s/ John W. McIlvaine
John W. McIlvaine (PA ID. No. 56773)
Anthony W. Brooks (PA ID No. 307446)

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